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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,357	06/19/2001	Lothar K. Faber	A7694	9655

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EXAMINER

NGUYEN, THONG Q

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 04/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,357

Applicant(s)

FABER, LOTHAR K.

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It was not executed in accordance with either 37 CFR 1.66 or 1.68.

Drawings

2. The drawings contain eight sheets of figures 1-7D filed on 06/19/2001 have been received by the Office.

3. The drawings are objected to because it is unclear which component(s) do(es) the numerical reference "3" refer to. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: In particular, the nosepiece "28" as stated in page 4, line 15 is not shown in at least one figure. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: In

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particular, the references "A" and "B" as shown in figure 5 is not mentioned in the specification, and the values shown in each figures 7B-7D are not mentioned in the specification. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature concerning the type of reflected light fluorescence as recited in the claim must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

8. The disclosure is objected to because of the following informalities: a) Page 2: lines 7-9, the description thereof "When the nosepiece... field of view" is unclear. What does applicant mean by that description? b) Page 4: line 2, what kind of "Petri dish" does applicant mean here? c) Page 4: line 5, what kind of illuminator does applicant

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mean by "GFP"? d) Page 4: lines 8-9 and 12, applicant has used different references, i.e., 13 and 24, for the same power supply; e) Page 4: lines 9 and 12, applicant has used different references, i.e., 16 and 22, for the same switch box; f) Page 4: lines 9 and 12, what is/are difference(s) between the so-called "fiberoptic cable 14" (line 9) and "fiberoptic bundle 21" (line 12)? G) Page 4: line 14, what does applicant mean by "special combining prism"? h) Page 4: lines 15 and 16, the different references, i.e., 9 and 28, are used to refer to a nosepiece; I) Page 4: lines 20 and 21, different references, i.e., 33 and 36, are used to refer to the same filter module. There are still some grammatical and idiomatic errors in the specification. Applicant should carefully proofread the specification. Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected under 35 USC 112, second paragraph for the following reasons: First, the claim recites a stereo microscope body that is shiftable about an axis to be placed properly over the stereo lens or the compound lens (see lines 7-8 of the claim); however, the claim fails to recites a mechanism for performing such a function. In other words, it is unclear how the microscope body can be shifted and then placed properly over one selected lens; Second, the

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feature thereof "a prism shift...image created" (lines 11-12) is indefinite. What does applicant mean by that feature? In other words, the terms thereof "to create binocular images from a single axis compound image created" (lines 11-12) is indefinite.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 1, as best as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Koyama et al (U.S. Patent No. 6,226,118) in view of Spitznas et al (U.S. Patent No. 4,710,000).

Koyama et al disclose a fluorescent microscope having illuminating systems for providing transmitting light and/or reflecting light to a fluorescent sample. In their microscope, they teach the use of a mechanism supporting a plurality of filtering sets each comprises a dichroic mirror, an exciting filter and a barrier filter (see column 9 and figs. 5-7) and each is able to select to insert into the optical path of the microscope over a selected objective lens system; and a revolver for supporting at least two objective lens systems (21, 22 or 81,82) wherein each objective lens is able to select to enter into the optical path (see columns 7-8 and figs. 1, 4 and 19, for example) for providing a desired illumination and observation. While the objective lens systems used by Koyama et al are not

clearly defined as stereo and/or compound lens systems as recited in the present claim; however, it is noted that the present claim does not provide any specific limitations/features of the so-called "stereo lens" and "compound lens" used in the claim; and it would have been obvious to one skilled in the art at the time the invention was made to use a revolver for supporting any kind of suitable objective lens systems in the market or known in the art in the system provided by Koyama et al for the purpose of selecting a particular set of objective lens system in the optical path for meeting a desired illumination/observation. As a result of the structure of the microscope described in columns 7-10, the only feature missing from the art of Koyama et al is that it does not clearly state that the microscope is a binocular or stereoscopic microscope by using a prism shift mechanism for providing binocular images from the light passing through the selected objective lens system. However, one skilled in the art as can be seen in the stereoscopic microscope provided by Spitznas et al knows the use of a set of prism elements in a microscope for the purpose of providing binocular or stereoscopic images to a user. In particular, at columns 3-4 and figure 9, Spitznas et al disclose the use of a set of prism systems (20 and 24) wherein one of prism system is selectively chosen to be placed into the light path for providing either a stereoscope observation or a normal observation. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the microscope provided by Koyama et al by using a set of prism systems as suggested by

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Spitznas et al wherein a particular prism system is selectively chosen to enter into the light path for providing a desired observation.

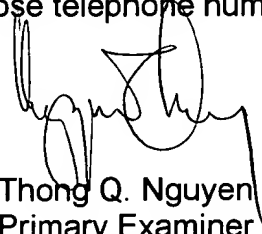
Conclusion

13. The additional references are cited as of interest in that each discloses a microscope having a revolver for supporting a plurality of different objective lens systems wherein a particular objective lens system is able to select to enter the optical path of the microscope.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is 703 308 4814. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on 703 308 1687. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 7724 for regular communications and 703 308 7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q. Nguyen
Primary Examiner
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March 26, 2002